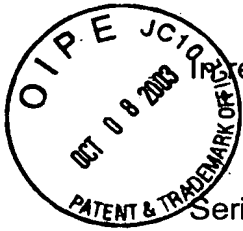


Docket No.: 3350-031F  
File No.: 1158.41324CC6  
Client Ref.: BillPay-F

PATENT

*11/19/03*  
*PJF*  
*10/21/03*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re Application of

Peter J. Kight et al.

Serial No. 09/540,011

: Group Art Unit: 3625

: Examiner: Y. Garg

Filed: March 31, 2000

For: BILL PAYMENT SYSTEM AND METHOD WITH A MASTER MERCHANT

**RECEIVED**

OCT 14 2003

**GROUP 3600**

**APPEAL BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

October 9, 2003

Sir:

This Appeal Brief is submitted (in triplicate) in support of the Notice of Appeal filed on August 8, 2003.

I. **REAL PARTY IN INTEREST**

CheckFree Corporation is the assignee of all rights in this application. Accordingly, CheckFree Corporation is the Real Party In Interest.

II. **RELATED APPEALS AND INTERFERENCES**

Related U.S. Application Serial Nos. 09/542,109, 09/540,011 and 09/541,362, all of which claim parentage from the same originally filed application as the present application, are currently under appeal.

III. **STATUS OF CLAIMS**

Claims 36-50 are pending in this application. Each of claims 36-50 is under appeal.

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IV. **STATUS OF AMENDMENTS**

A Preliminary Amendment, filed concurrently with the filing of this Rule 53(b) Continuation application, and an Amendment filed on November 27, 2002 have been entered. A Request for Reconsideration was also filed on April 10, 2003.

V. **SUMMARY OF INVENTION**

In summary, the present invention is directed to establishing merchants to be paid. A preferred embodiment of the invention is described on page 6, line 15, through page 9, and in Figure 2 of the present specification. In accordance with aspects of the invention, the consumer informs the service provider or processor of the merchant information, including the consumer's account, and this information is placed in the merchant master file database (MMF) 42. The consumer may also indicate, for example, that the merchant is a fixed merchant, and the date on which the merchant is to be paid and the amount to be paid (see for example, page 7, lines 4-6). Thus, as described on pages 6 and 7, a request for payment can be made at the same time a merchant is added to the master merchant file database.

As described on pages 8 and 9, when a payment record (i.e., a request to pay a bill associated with a merchant on behalf of a consumer) is received, it is validated by checking for a duplicate payment and by verifying that the merchant is set up. As explicitly disclosed on page 8, if a duplicate payment is found, the payment record is sent to the rejection file. On the other hand, if it can not be verified that the merchant is set up, the consumer pay table 38 is updated to add the new merchant record, and if the merchant record does not already exist, the merchant record will be created on the master merchant file database (MMF) 42, as described on page 8, lines 10-17.

In summary, in accordance with the present invention, a consumer can request a payment at the time the consumer initially establishes merchants in the master

merchant file database (MMF) 42, as described on pages 6 and 7. On the other hand, the consumer may also update the master merchant file database (MMF) 42 to include an additional merchant at the time of requesting a payment, as described on pages 8 and 9.

VI. **ISSUES**

Whether claims 36-50 are anticipated, under 35 USC §102(e), by Landry (U.S. Patent No. 5,956,700).

VII. **BRIEF DESCRIPTION OF THE REFERENCES**

Landry is a Continuation of U.S. Application Serial No. 08/253,364, filed on June 3, 1994.

VIII. **THE REJECTION**

In the final Official Action dated February 12, 2003, the claimed priority date of July 25, 1991 is denied, claims 36, 38, 41, 43-46 and 48-50 stand rejected under 35 USC §112, first paragraph, and claims 36-50 stand rejected under 35 USC §102(e), as anticipated by Landry (U.S. Patent No. 5,956,700).

In an Advisory Action issued on May 9, 2003, in response to the Request for Reconsideration filed on April 10, 2003, the rejection under 35 USC §112, first paragraph, is withdrawn, but the denial of the claimed priority and the anticipation rejection are maintained.

In a further Advisory Action issued on October 1, 2003, in response to a Communication filed on August 28, 2003 which highlighted the grant of a Petition overturning a similar denial of priority on a related application, the denial of the priority date of July 25, 1991 was withdrawn, but the prior art rejection was maintained.

IX. **ARGUMENT**

Applicants respectfully traverse the rejection based on prior art applied against the claims now pending on appeal. As discussed below, it is respectfully submitted that the reference applied in support of the anticipation rejection under 35 USC §102(e), is not prior art with respect to the present application.

More particularly, as noted above, the applied Landry patent carries a priority date of June 3, 1994. The present application has a priority date of July 25, 1991. Accordingly, Landry is not prior art with respect to the present application.

Accordingly, the Examiner has failed to establish a prima facie basis for the rejection under 35 USC §102(e). Indeed, Landry does not and can not anticipate the present invention.

X. **CONCLUSION**

It is respectfully submitted that the Examiner has failed to establish a prima facie case for the rejection. Thus the rejection of the pending claims, as anticipated under 35 USC 102(e) over the applied art, is improper.

In summary, Applicants respectfully submit that the applied reference is not prior art with respect to the present invention and thus can not, under any reading, anticipate the present claims. Thus, the rejection of the pending claims is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of

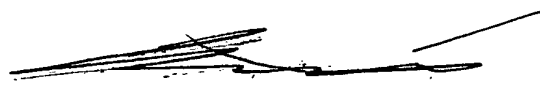
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this paper, including extension of time fees, to the Deposit Account No. 01-2135  
(Case No. 1158.41324CC6) and please credit any excess fees to such Deposit  
Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read 'Alfred A. Stadnicki', with a long horizontal stroke extending to the right.

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